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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: H. KOIKE, et al

Serial No.: 09/473,277

Filed: December 28, 1999

For: METHOD OF AND A SYSTEM FOR DISTRIBUTING DIGITAL CONTENTS

Group: 3621

Examiner: J. Worjloh

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DEC 02 2003

GROUP 3600

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

November 26, 2003

Applicants hereby confirm their election of claims 22, 24, 26, 29 and 32 for further prosecution on the merits.

In paragraph 7 of the Office Action the Examiner rejected claims 22, 29 and 32 under 35 USC §101 being that the Examiner alleges that the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner alleges that the claims are directed to a process that does nothing more than manipulate an abstract idea. The Examiner argues that there is no practical application in the technical arts. This rejection is traversed for the following reasons. Applicants submit that the claims are clearly directed to statutory subject matter as required under 35 USC §101. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

As specifically required by 35 USC §101, in order for an invention to be patentable it must be directed to “any new and useful process, machine, manufacture of composition of matter”. Each of claims 22, 29 and 32 are clearly directed to statutory subject matter. For example, claim 22 is directed to a digital contents distribution method to distribute digital content via a network (process); claim 29 is directed to a computer readable medium storing a program for executing a digital contents distribution method to distribute digital content via network (article of manufacture) and claim 32 is directed to a program file storing a program for distributing a digital content via a network (article of manufacture).

In order for the Examiner to understand such claims, the Examiner’s attention is directed to the guidelines for examining computer implemented inventions as set forth in MPEP 2106. Therein it specifically describes that statutory subject matter exist when claims are directed to a method (process) of distributing a program in a network and computer programs that are stored on a storage medium or a file. These claims are specifically provided for and constitute computer implemented inventions directed to a method and a article of manufacture as permitted under 35 USC §101.

Further, contrary to the Examiner’s unsupported allegations, the specification and the drawings of the present invention clearly describe and illustrate a practical application that produces a “useful, concrete and tangible result”. The practical application, for example, as discussed on page 1, lines 2-9 of the specification and as illustrated in Figs. 1-6, of the present invention relates to a digital contents distribution system to distribute contents and in particular to a technology efficiently

applicable to a digital contents distribution system in which an original document such as a book is digitized into a digital content and the content digitized is distributed from a content management center to store such that a digital content selected by a customer is sold in the stores. This clearly described and illustrated practical application produces a “useful, concrete and tangible result” in that documents such as books can be digitized and distributed to stores across a network thereby avoiding the shipping and handling associated with the distribution of paper versions of such documents.

Even beyond the above, each of the steps of elements recited in the claims corresponds to specific well known and understood apparatus. For example, the step of “selecting” is performed by the sales processing section 612 of the vending device 140 which is implemented by an information processing apparatus having a keyboard, memory, display and CPU, the Examiner’s attention is directed to Fig. 13. The step of “generating” is performed by the distribution control section 411 of the content database device 120 which is implemented by an information processing apparatus having a keyboard, memory, display and CPU, the Examiner’s attention is directed to Fig. 10. The step “instructing” is performed by the distribution control section 411 of the content database device 120, the Examiner’s attention is directed to Fig. 10. The step of “selling” is performed by the sales processing section 612 of the vending device 140, the Examiner’s attention is directed to Fig. 13.

Thus, as is quite clear from the above, the present invention is directed to a computer implemented invention, namely a process and an article of manufacture having stored thereon a program, and hence is clearly statutory subject matter

under 35 USC §101. Accordingly, reconsideration and withdrawal of the 35 USC §101 rejection of claims 22, 29 and 32 is respectfully requested.

Claims 22, 26, 29 and 32 stand rejected under 35 USC §103(a) as being unpatentable over Muyres (U.S. Patent application No. 2002/0002488) in view of Miller (U.S. Patent No. 5,920,701); and claim 24 stands rejected under 35 USC §103(a) as being unpatentable over Muyres, Miller and further in view of Van Wie (U.S. Patent No. 5,943,422). These rejections are traversed for the following reasons. Applicants submit that the features of the present invention as recited in claims 22, 24, 26, 29 and 32 are not taught or suggested by Muyres, Miller or Van Wie whether taken individually or in combination with each other as suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

The present invention as recited in the claims is directed to a digital contents distribution method, system, computer program and program file in which digital contents are distributed according to distribution scheduling which is generated as a result of determining that the stores or the vending devices do not have saved therein digital contents selected by customers. Thus, according to the present invention attempts to provide an orderly transmission and storage of selected digital content into the vending devices so as to satisfy the request by customers selecting such digital contents from the vending devices are satisfied. Therefore, by use of the present invention unnecessary communications on the network connecting the vending devices and distribution centers can be avoided by scheduling such

distribution at particular times such as, for example, when traffic is low on the network.

The above described features of the present invention now more clearly recited in the claims are not taught or suggested by Muyres, Miller or Van Wie whether taken individually or in combination with each other as suggested by the Examiner. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the above noted rejections.

The above described features of the present invention are not taught or suggested by Muyres. Muyres teaches a locally driven advertising system for providing offline advertising. As taught by Muyres information is accumulated prior to formal purchase and such accumulated information once accumulated can be purchased at a later point in time. The Examiner's attention is directed to paragraph 0092 of Muyres. Muyres teaches that stores of digital contents vending machines (DCVM) includes digital contents from two sources namely pre-positioned digital content and extended or master inventory content. Attention is directed to paragraph 0127 of Muyres.

The above described teachings of Muyres does not teach or suggest the features of the present invention as clearly recited in the claims. Particularly, Muyres does not teach or suggest that digital contents is distributed to a store, when the selected digital contents is not saved in the store as recited in the claims.

According to the present invention, digital contents are distributed from the content database center via the distribution management center to the vending device of a store without a distribution request from the store. According to the

present invention only upon an occurrence when a selected digital content is not cached in the vending device of the store, is the distribution request sent to the distribution management center or the contents database center so as to distribute the selected digital contents to the vending device of the store. Such features are clearly not taught or suggested by Muyres.

Thus, the features of the present invention as recited in the claims are not taught or suggested by Muyres. The above noted deficiencies of Muyres are not supplied by any of the other references of record particularly Miller and Van Wie. Therefore, combining the teachings of Muyres with one or more of Miller and Van Wie still fails to teach or suggest the features of the present invention as now more clearly recited in the claims.

Miller merely teaches that a scheduler creates a distribution schedule based on a request from the contents sources. The Examiner's attention is directed to col. 2, lines 2-4 of Miller.

Van Wie merely teaches the necessity of implementing digital right management in analog-to-digital conversion.

Thus, it is clear that neither Miller or Van Wie teach or suggest the above noted deficiencies of Muyres. Therefore, combining the teachings of Muyres with one or more of Miller and Van Wie still fails to teach or suggest the features of the present invention as now more clearly recited in the claims. Accordingly, reconsideration and withdrawal of the 35 USC §103(a) rejections of the claims based on Muyres, Miller and Van Wie is respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references utilized in the rejection of claims 22, 24, 26, 29 and 32.

In view of the foregoing amendments and remarks, Applicants submit that claims 22, 24, 26, 29 and 32 are in condition for allowance. Accordingly, early allowance of claims 22, 24, 26, 29 and 32 is respectfully requested.

To the extent necessary, the applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (500.38037CX1).

Respectfully submitted,

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